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Katrin Reisinger

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EXAMINER

VETTER, DANIEL

ART UNIT

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3628

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PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/797,494	<b>Applicant(s)</b> REISINGER, KATRIN	
	<b>Examiner</b> DANIEL P. VETTER	<b>Art Unit</b> 3628	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 29 December 2007.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                     | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

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## **DETAILED ACTION**

### **Status of the Claims**

1. Claims 1-14 were previously pending in this application. Claim 14 was amended in the reply filed December 29, 2007. Claims 1-14 are currently pending in this application.

### ***Response to Arguments***

2. Applicant's amendment to claim 14 overcomes the objection made to this claim and it is withdrawn.

3. Applicant's arguments filed December 29, 2007 have been fully considered but they are not persuasive.

4. In response to applicant's argument based upon the age of the references, contentions that the references are old are not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. See *In re Wright*, 569 F.2d 1124, 193 USPQ 332 (CCPA 1977).

5. In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

6. In response to applicant's argument that the combination of references is improper, examiner maintains that the references teach all positively recited limitations of the claims and that it would have been obvious to combine their respective teachings to arrive at applicant's claimed invention. Modification of Uno's description of hardware elements with the franking functionality of Guenther would be obvious because it is

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merely a combination of old elements. In the combination each element would have performed the same function as it did separately, and one skilled in the art would have recognized that the results of the combination were predictable. With regard to the addition of the product code feature, since each individual element and its function are shown in the prior art, albeit shown in separate references, the difference between the claimed subject matter and the prior art rests not on any individual element or function but in the very combination itself. That is, in the substitution of the product codes taught in USPS Minutes for the codes disclosed in Guenther as applied to Uno. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate product codes because it is merely the simple substitution of one known element for another that can be done by routine engineering producing predictable results.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 12, and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uno, et al., U.S. Pat. No. 5,535,127 (Reference A of the PTO-892 part of paper no. 20070404) in view of Guenther, et al., U.S. Pat. No. 5,852,813 (Reference B of the PTO-892 part of paper no. 20070404) and U.S. Postal Service, *Minutes of the Mailers' Technical Advisory Committee*, Dec. 10-11, 1997 (Reference U of the attached PTO-892) (hereinafter "USPS Minutes").

9. As per claim 1, Uno teaches a mail-processing device comprising: a programmable memory having a table stored therein containing a plurality of codes (column 1, line 19; Fig. 36); a program memory containing an operating program

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(column 5, line 23); a working memory having mail-item-related data values stored therein (column 5, line 25); a keyboard having a plurality of operating elements allowing manual entry of said mail-item-related data values for said mail item into said working memory (column 5, line 44); a microprocessor in communication with said programmable memory, said program memory, said program memory, said working memory, and said keyboard (column 5, line 21); said programmable memory, said working memory and said microprocessor, in combination, being programmable by said operating program to set an operating mode for automatic code entry (column 5, lines 48-50); and said microprocessor being programmed in said operating mode to evaluate said mail-item-related data values stored in said working memory and to automatically select an applicable code from among said plurality of codes stored in said table stored in said programmable memory (column 5, lines 29-40; column 15, lines 1-6, Table).

Uno does not teach the operating program is to generate print data for a franking imprint to be printed on a mail item that includes said applicable code; taught by Guenther (column 3, lines 31-35; column 5, lines 45-47). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in order to provide robustly franked mail pieces fully prepared for mailing (as taught by Guenther; column 5, lines 31-37).

Uno in view of Guenther does not explicitly teach the codes are product codes; which is taught by USPS Minutes (page 11, Parcel Barcode Clarification). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of USPS Minutes into the device taught by Uno in view of Guenther because product codes are useful to eliminate special service labeling requirements (as taught by USPS Minutes; page 11, Parcel Barcode Clarification).

10. As per claim 2, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Uno further teaches said table in said programmable memory comprises a plurality of columns, each of said columns comprising a plurality of rows, and including first and second columns containing datasets representing defaults

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for valid shipping parameters (Fig. 26), and wherein said microprocessor is programmed for row-by-row searching through said first and second columns to identify datasets in said first and second columns corresponding to said values stored in said working memory and, for the valid shipping parameters represented by said datasets, said microprocessor evaluating structures in remaining columns of said table (column 15, lines 1-4; column 16, lines 59-67; Fig. 37).

11. As per claim 3, Uno in view of Guenther and USPS Minutes teaches the device of claim 2 as described above. Uno further teaches a display device connected to said microprocessor (column 1, line 53) and wherein said microprocessor is supplied with a weight selected from the group consisting of an entered weight and a measured weight (column 4, line 15), and wherein said table is a first table stored in a first memory range of said programmable memory (column 5, lines 28-30), said programmable memory having further memory ranges in which further tables are respectively stored (column 7, lines 31-32; while Examiner recognizes that Uno does not explicitly use the term "range," it is noted that memory inherently is comprised of multiple address ranges, Microsoft TechNet: *Memory*, printed 4/5/2007, Reference U of the PTO-892 part of paper no. 20070404), including a weight table for determining a table index assigned to different weights (column 7, lines 51-65), and a product code table for determining a product code assigned to said table index (column 21, lines 15-35), and wherein said microprocessor is programmed for storing a start address of said first table in said programmable memory (column 5, lines 28-29), for generating a screen image for shipping parameters associated with said values stored in said working memory and for displaying said screen images on said display device (column 1, line 53), and for accessing said tables in said programmable memory for evaluating data values in a row of said first table in said programmable memory, said data values corresponding to the values stored in said working memory (column 1, lines 51-52; column 22, lines 34-50) and designating, to said product code table, designated product codes (column 22, lines 45-50), and said microprocessor being programmed for storing the product codes

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designated with the table index for said weight (column 22, line 51). Guenther further teaches that the designating is done by a pointer (column 24, lines 66-67). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes in order to reference a further data set (as taught by Guenther; column 24, line 67 - column 25, line 1).

12. As per claim 4, Uno in view of Guenther and USPS Minutes teaches the device of claim 2 as described above. Uno further teaches a display device connected to said microprocessor (column 1, line 53) and wherein said microprocessor is supplied with a weight selected from the group consisting of an entered weight and a measured weight (column 4, line 15), wherein said table is a first table stored in a first memory range of said programmable memory (column 5, lines 28-30), said programmable memory having further memory ranges in which further tables are respectively stored (column 7, lines 31-32; while Examiner recognizes that Uno does not explicitly use the term "range," it is noted that memory inherently is comprised of multiple address ranges, see Microsoft TechNet: *Memory*), including a weight class table for determining a table index assigned to a weight class code stored in a further memory (column 7, lines 51-65; Fig. 36), and a product code table for determining a product code assigned to said table index (column 21, lines 15-35), and wherein said microprocessor is programmed for storing a start address of said first table in said programmable memory (column 5, lines 28-29), for generating a screen image for shipping parameters associated with said values stored in said working memory and for displaying said screen images on said display device (column 1, line 53), and for accessing said tables in said programmable memory for evaluating data values in a row of a table in said programmable memory, said data values corresponding to the values stored in said working memory (column 1, lines 51-52; column 22, lines 34-50) and designating, to said product code table, designated product codes (column 22, lines 45-50), and said microprocessor being programmed for storing the product codes designated with the

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table index for a weight class in which said weight occurs (column 22, line 51; Fig. 36). Guenther further teaches that the designating is done by a pointer (column 24, lines 66-67). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes in order to reference a further data set (as taught by Guenther; column 24, line 67 - column 25, line 1).

13. As per claim 5, Uno in view of Guenther and USPS Minutes and Guenther teaches the device of claim 4 as described above. Uno further teaches a receiver unit (column 5, line 41). The limitation "for loading and storing table values and data for entry into at least one of said table, said weight table, said product code table and said weight class table" is merely a statement of intended use and is only given patentable weight inasmuch as it implies structural limitations to the claim, which are met by the teachings of Uno (column 5, line 41).

14. As per claim 6, Uno in view of Guenther and USPS Minutes teaches the device of claim 4 as described above. Uno further teaches an interface adapted for connection to the postage meter machine (column 1, lines 18-21), and wherein said working memory temporarily stores at least one of said weight class code and said product code in respective memory areas (column 7, lines 51-63). Guenther further teaches wherein said microprocessor is programmed to transmit at least one of said weight class code and said product code to the postage meter machine via said interface (column 10, lines 30-34). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes in order to calculate the postage (as taught by Guenther; column 10, line 31).

15. As per claim 7, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Uno further teaches an interface in communication with said microprocessor (column 5, line 44). The limitation for setting said operating mode is a statement of intended use and is only given patentable weight to the extent that it



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imparts structural limitations to the invention, which are met by the teachings of Uno (column 5, line 44).

16. As per claim 8, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Guenther further teaches wherein one of said operating elements of said keyboard, when actuated, sets said operating mode (column 13, lines 12-13). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes because keyboard actuation can be used to initiate device functionality (as taught by Guenther; column 13, lines 12-13).

17. As per claim 9, Uno in view of Guenther and USPS Minutes teaches the device of claim 1 as described above. Uno further teaches a receiving unit connected to said programmable memory (column 5, line 46). The limitation for loading said table is merely a statement of intended use and is only afforded patentable weight to the extent that it imparts structural limitations on the invention, which are met by the teachings of Uno (column 5, line 46).

18. As per claim 10, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Uno further teaches wherein said receiver unit is a modem selected from the group consisting of analog modems and digital modems (column 5, line 46).

19. As per claim 12, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Guenther further teaches wherein said receiving unit is a chip card reader adapted to receive a chip card having a memory in which said table is stored (column 7, lines 1-3). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the device taught by Uno in view of Guenther and USPS Minutes to allow mobility for the mail processing system (as taught by Guenther; column 7, line 4).

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20. As per claim 14, Uno teaches a computer-readable medium encoded with a data structure for a mail-processing device having a programmable memory (column 1, line 19), a working memory (column 5, line 25) and a microprocessor programmed to operate in an operating mode for automatic code entry (column 5, lines 21, 48-50), and having a receiver unit in communication with the microprocessor (column 5, line 26), said data structure comprising a plurality of memory areas in which are stored (column 5, lines 24-30), respectively, an application program for said automatic code entry (column 22, lines 45-51) and for generating screen images for shipping parameters on a display device (column 1, line 53), at least one first table in one of said memory areas and respective further tables in further memory areas to which access is enabled by said application program (column 7, lines 51-65; column 21, lines 15-35), said first table comprising columns of data values for valid shipping parameters (column 15, Table), and a weight table (column 7, lines 51-65), a code table (column 15, Table; column 21, lines 15-35) and a weight class table (column 7, lines 51-65; Fig. 36), all of said tables being loadable from computer-readable into said programmable memory via said receiver unit (column 5, lines 46-47). Uno does not teach that there are pointers to the data; taught by Guenther (column 24, lines 66-67). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of Guenther into the medium taught by Uno in order to reference a further data set (as taught by Guenther; column 24, line 67 - column 25, line 1). Uno in view of Guenther does not explicitly teach the codes are product codes; which is taught by USPS Minutes (page 11, Parcel Barcode Clarification). It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above teachings of USPS Minutes into the medium taught by Uno in view of Guenther because product codes are useful to eliminate special service labeling requirements (as taught by USPS Minutes; page 11, Parcel Barcode Clarification).

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21. Claims 11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Uno, et al. in view of Guenther, et al. and USPS Minutes as applied to claim 9 above, in further view of Official Notice.

22. As per claim 11, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Uno does not explicitly teach wherein said receiving unit is a drive device adapted to receive a data carrier on which said table is stored, selected from the group consisting of CDs and DVDs. Official Notice was previously taken and considered admitted prior art that it is old and well-known in the art for drive devices to receive data from CDs and DVDs employed as storage data carriers. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the device taught by Uno in view of Guenther and USPS Minutes because CDs and DVDs are reliable data storage media commonly used to transfer data between devices.

23. As per claim 13, Uno in view of Guenther and USPS Minutes teaches the device of claim 9 as described above. Uno does not explicitly teach wherein said receiving unit is a memory stick interface adapted to receive a memory stick having a memory in which said table is stored. Official Notice was previously taken and considered admitted prior art that it is old and well-known in the art for drive devices to receive data from memory sticks employed as storage data carriers. It would have been prima facie obvious to one having ordinary skill in the art at the time of invention to incorporate the above finding of Official Notice into the device taught by Uno in view of Guenther and USPS Minutes because memory sticks are reliable data storage media commonly used to transfer data between devices.

### ***Conclusion***

24. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

25. Any inquiry concerning this communication or earlier communications from the examiner should be directed to DANIEL P. VETTER whose telephone number is (571)270-1366. The examiner can normally be reached on Monday through Thursday from 8am to 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Hayes can be reached on (571) 272-6708. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/John W Hayes/

Supervisory Patent Examiner, Art Unit 3628